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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) PAT 2835-2	
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		First Named Inventor Steve O'HALLORAN et al.	
		Art Unit 3627	Examiner Joseph A. FISCHETTI
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 45,291 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Anne Kinsman Typed (r printed name (613) 237-5160 Telephone number June 13, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: O'HALLORAN, Steve; NORRIE, Ross
Serial No.: 09/886,687
Filed: June 21, 2001
Title: SOFTWARE AND HARDWARE COMPONENT AUDIT AND
INVENTORY MANAGEMENT SYSTEM
Group: 3627
Examiner: FISCHETTI, Joseph A.
Attorney Ref.: PAT 2835-2 US

June 13, 2006

Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

We submit that this case is appropriate for the pre-appeal process as the Final Action, which is a new ground of rejection, clearly fails to demonstrate a *prima facie* case of obviousness for any of the pending claims, there are clear errors in the rejections, and the rejections omit essential elements for a *prima facie* rejection.

Clear errors suitable for a pre-appeal review include:

- 1) lack of *prima facie* case for rejecting claim 33;
- 2) failure to provide reasons for rejecting claim 1;
- 3) clear error in taking official notice and failure to establish *prima facie* case of obviousness for claims 2, 3, 4, 41, 7, and 8; and
- 4) inappropriate restriction.

1) Lack of *prima facie* case for rejecting claim 33

In our response to the Final Action, at pages 6-8, we presented arguments indicating that Fleming does not teach or suggest all the claimed limitations; that there is no teaching or suggestion in Fleming to modify its teachings to arrive at the claimed invention; and that, even if Fleming were modified, there would be no reasonable expectation of success and such modification would not result in the invention as claimed herein. We direct the pre-appeal panel to those arguments, which we believe should be convincing on their own.

In order to demonstrate that the rejection is clearly deficient, we include claim 33, with emphasis added:

33. A component audit and inventory management system comprising:

a host unit, resident in a host computer, the host computer comprising a processor, memory, and user interface; and

a host message handling system operatively connected to the host unit and accessible to a data network;

the host unit including:

means for receiving a request-inventory message from a client computer via the host message handling system,

means for generating an inventory-commence message in response to the request-inventory message, and for forwarding the inventory-commence message to the client computer via the host message handling system;

means for receiving hardware and software inventory data associated with hardware and software installed on a target device associated with the client and collected electronically from the target device, the inventory data having been collected by an inventory agent installed on the target device and activated by the inventory-commence message; and

means for aggregating inventory data from a plurality of target devices associated with the client.

Accordingly, at a very basic level, claim 33 references **an inventory agent, a client computer, a target device associated with the client and a host unit.**

Even if we were to ignore the details of the claims, Fleming simply does not teach or suggest the use of **an inventory agent** at all, and does not in any way teach the use of all three of a **client computer, a target device associated with the client and a host unit** as claimed.

This can be seen with ease by simply comparing Figure 1A of the present application, with Figure 1 of Fleming. We are cognizant of the fact that Figure 1A of the present application, merely illustrates an embodiment of the invention, and we are mindful that it is not what is shown in Figure 1A, but what is claimed in claim 33 which is important. However, it is submitted that merely contrasting these two figures clearly illustrates errors in the rejection. Our Figure 1A shows a **host unit 10**, a **client computer 16**, a **target device (for example 20)**, and an **inventory agent 300**. Figure 1 of Fleming (the only figure relied on in the rejection) clearly does not show an inventory agent, and does not show a **client computer, a target device associated with the client and a host unit.**

In order to try and force a rejection based on the Fleming reference, the examiner considers device 102 to be the target device, the computer system 108 to be the host unit, and the server 112 to be the client computer. This is erroneous as we argued in our response to the Final Action at pages 6 - 8. Further, the rejection is clearly in error in that IF computer system 108 is the host unit, and 112 is the client computer, then there is **NO target device associated with the client** as device 102 is clearly associated

with computer 108, and not server 112.

Consequently, even at such a very high level, Fleming fails to teach or suggest the claimed invention. The rejection is therefore clearly erroneous. We re-iterate our arguments in our response to the Final Action, at pages 6-8, which explains in more detail not only how the claims differ from what is taught by Fleming, but also why the rejection is erroneous.

Furthermore, the statement at page 3 of the Final Action that the "step of aggregating inventory data from a plurality of target devices associated with the client is deemed to be a mere repetition of parts to take the same information from one source as opposed to plural ones is not deemed to be patentable" is simply not supported, and is clearly erroneous. Simply making an assertion that a limitation is not deemed to be patentable fails to satisfy the burden of the examiner to establish a *prima facie* case of obviousness. This limitation further distinguishes over Fleming, as we are claiming an inventory management system which manages inventory data from a plurality of devices. This is very different from Fleming, which is directed to retrieving a device driver for a single device.

2) Clear error exists as the rejection fails to provide any reasons for rejecting claims 1 - 5, 7 and 8

The examiner has failed to establish any reasons for rejecting claim 1. Consequently it is clear that the Final Action fails to establish a *prima facie* case for rejecting claim 1, and its dependent claims 2 - 5, 7 and 8. Furthermore, as we argue in our response to the Final Action, at the bottom of page 8 to the top of page 9, claim 1 clearly is not taught or suggested by Fleming.

3) Clear error in taking official notice and failure to establish *prima facie* case of obviousness for claims 2, 3, 4, 41, 7, and 8

a) Clear error is made by taking official notice of contingent authentication as the sole and only basis for rejecting claims 2 and 3

The examiner is clearly in error in taking official notice of contingent authentication in a Final Action, without documentary evidence to support the conclusion, since there is no evidence that such authentication is capable of instant and unquestionable demonstration as to defy dispute (see MPEP 2144.03).

In any event, even if it is appropriate to take official notice of contingent authentication (which is denied, especially in a Final Action), this does not suffice to reject the claimed subject matter. There is no teaching in Fleming to suggest an inventory agent as claimed in claims 2 and 3. Indeed, as stated above, there are no reasons given for rejecting claim 1, which claims an inventory agent. In rejecting

claim 33, the examiner reads the device interface 103 as an inventory agent.

Further, in the Advisory Action, at line 14, the examiner states: "in the alternative, the device 102 is deemed fully capable of functioning as an inventory agent as specified in the claims." This once again demonstrates both the differences between the claimed invention and the Fleming reference, and the Examiner's failure to appreciate these differences. It is a clear error to take official notice of such a device, or device interface, as being capable of contingent authentication. The panel is directed to the description of the device 102 and interface 103 at col. 4, lines 4 -15 of Fleming. The example devices, which include a video card, sound card, scanner, printer, keyboard, and others, are NOT capable of contingent authentication, nor would a person skilled in the art be motivated to make them so. More importantly, no person skilled in the art would be motivated to modify the teachings of Fleming to achieve an inventory agent as claimed in claims 2 and 3. In any event, there are clear errors in the rejection as the examiner has failed to provide any reason why a person skilled in the art would be motivated to do so, and has most certainly not provided any evidentiary basis for so doing.

b) Clear error in taking official notice that the use of email is old in the art as the sole and only basis for rejecting claims 4 and 41

The fact that email is known is not in dispute, and we do not dispute that the existence of electronic mail systems is an appropriate fact of which official notice may be taken. However, that fact is irrelevant to the patentability of claims 4 and 41, and the rejection ignores the claimed invention in its entirety, but for the fact that electronic mail is recited. We strongly dispute the statement "use of email is old in the art". The use of email is definitely NOT old in the art of inventory management systems. Previous inventory management systems required a dedicated LAN connection, and "there has been no similar effective strategy to manage devices that are only intermittently accessible to a LAN or other data network." (see e.g. Background of present application, p. 3, lines 13 - 21). In any event, the teachings of Fleming would not lead a person skilled in the art to invention as claimed in claims 4, and 41. There is no teaching in Fleming to suggest the target device would have an email account or be capable of retrieving an email message. This once again demonstrates both the differences between the claimed invention and the Fleming reference, and the Examiner's failure to understand those differences.

c) Clear error in taking official notice that the storage of a log file is old in the art as the sole and only basis for rejecting claims 7 and 8

The examiner is clearly in error in taking official notice in a Final Action that creation of a log file is old in the art of inventory management, without documentary evidence to support the conclusion, since

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there is no evidence that such log file creation is capable of instant and unquestionable demonstration as to defy dispute (see MPEP 2144.03) in the art.

4) Inappropriate Restriction

The restriction requirement made in the Office Action of August 5, 2005, and made final in the Final Action is clearly in error. The "species" identified by the examiner are not independent and distinct. The unelected claims are proper narrowing limitations to various elements in the system of claim 33. Where the claims of an application more precisely define the same essential characteristics of a single disclosed embodiment, restriction should never be required (MPEP 806.03). In addition, as previously argued in our response of November 1, 2005, there is no serious burden on the examiner in examining all the claims on their merits.

A Petition for a Two-Month Extension of Time is enclosed under separate cover. Applicant authorizes the Commissioner to debit any required fee from Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP. The Commissioner is further authorized to debit any additional amount required, and to credit any overpayment to the above-noted deposit account.

Respectfully submitted,
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